

## REMARKS

Applicant respectfully but completely disagrees with the Examiner's rejection of the claims under the *Thompson* reference. Notwithstanding, Applicant has amended the claims to further prosecution of the present case.

The Examiner has cited *Thompson* for the proposition that its cover is "transparent." Col. 2, lines 57, 61. Since no other word is used to describe the cover, *Thompson* does not teach or suggest to one skilled in the art to substitute another word, such as "translucent," for the term transparent. A Google search for "define: transparent" revealed the following definitions: "able to see through with clarity," "clear," and, "easily seen through." However, a Google search for "define: translucent" gave the following definitions: "allowing light to pass through, but not transparent" and, "allowing some light to pass through; objects seen through translucent material are diffused or indistinct." Clearly, these two words are not interchangeable and they have entirely different properties.

The distinction between "transparent" and "translucent" is important because of the Examiner's reliance on the other cited prior art reference, *Miyashita*. A complete English translation of *Miyashita* is attached for the Examiner's reference. The object of *Miyashita* is to make a label on a disk readable while the disk is rotating at high speed. The label contains "characters or an abbreviation representing the characteristics of the stored signals." Claim 3, paragraphs 1, 2, 6. The details that appear on the label must be stationary so that it can be properly read and understood. The only way to read the label while it is rotating is to "freeze" it or make it appear to be stationary with no movement. *Miyashita* specifically uses the term "synchronization" (paragraph 9), and it detects the actual number of revolutions of disk to emit light "in accordance with the number of revolutions of the optical disk." Claim 1, paragraph 4. Thus, *Miyashita* clearly intends to make the label appear stationary—not in motion.

Consequently, *Miyashita* teaches away from "giving an appearance of movement," and it provides no support to the Examiner's argument to make the cover "translucent" since that property would obscure the text on the label, making the label more difficult to read.

In further support of this point, Applicant notes the Federal Circuit very recently rejected an argument that "transparent" and "translucent" could be synonyms. See attachment citing *Terlep v. Brinkmann Corp.*, Fed. Cir., No. 04-1337, August 16, 2005.

Accordingly, Applicant has amended the claims to draw upon these distinctions and overcome the present rejections cited by the Examiner. Claim 1 now requires the cover to be "translucent but not transparent." This distinction alone is sufficient to overcome the present rejection. The Examiner cites *Thompson* only for transparency, and *Miyashita* relies on transparency to read the label on its disk. Mere translucency would obscure the label and make it difficult if not impossible to read, which would entirely defeat the objective of *Miyashita*. Claim 1 also requires "observation of at least some movement inside the housing of the disk, the hub, and the actuator through the cover during operation of the disk drive." In contrast, *Miyashita* teaches a "stationary" disk and teaches away from movement because any movement would make it difficult to read the label. Claim 1 is neither anticipated by nor obvious in light of the cited prior art references and is now in condition for allowance.

Dependent Claims 4 and 6-9 are allowable for the same reasons as Claim 1 in addition to their own unique features. For example, Claim 4 states that "the cover is tinted with a color." Since *Thompson* only uses the term "transparent" and *Miyashita* teaches clear, stationary perception of a rotating disk label, one skilled in the art would not substitute any properties that would defeat these teachings. Adding color would only make it more difficult to read the label. Similarly, Claim 6 adds that "a portion of the cover is structurally reinforced with materials that are opaque." Such a feature would also interfere with the reading of a disk label. Claim 10 adds

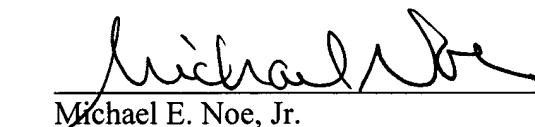
"decorations on at least one of the disk, the hub, and the actuator, wherein the decorations cause appearance of color, and change and movement of color depending on an angle of observation to additionally contribute to an appearance of the hard disk drive." The presence of any extraneous features, such as those described for Claims 10 and 11, would also interfere with the reading of the disk label. These claims overcome the prior art and are allowable.

Independent Claim 13 now requires the flashing device to "still give the appearance of movement of the disk, the hub, and the actuator." Again, *Miyashita* teaches no movement whatsoever. Claim 13 also now requires "a diffraction grating pattern on at least one of the disk, the hub, the actuator, and the cover to additionally contribute to an appearance of the hard disk drive." Such a feature would only interfere with the intent of the *Miyashita* reference. Dependent claims 14-20 essentially track the language of the preceding dependent claims and are likewise allowable.

Finally, independent Claim 21 requires "movement" like Claim 13, and "patterns on each of the disk, the hub, and the actuator, wherein the patterns cause appearance of color, and change and movement of color depending on an angle of observation to additionally contribute to an appearance of the hard disk drive" (emphasis added). The cited references provide no support for rejecting this claim and actually teach away from such a construction.

It is respectfully submitted that the claims are in condition for allowance and favorable action is requested. No fee for an extension of time or other fees are believed to be required. However, in the event that one or more fees are required, please charge them to **Hitachi Global Storage Technologies' Deposit Account Number 50-2587.**

Respectfully submitted,



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## News

### Patents/Claim Construction

#### Intrinsic Evidence Shows 'Clear' Means Only 'Transparent'; Does Not Cover 'Translucent'

The term "clear" for the plastic tubular holder in a claimed light emitting diode lamp excludes "translucent" holders like those in the patent infringement defendant's solar-powered pathway lamps, the U.S. Court of Appeals for the Federal Circuit ruled Aug. 16 (*Terlep v. Brinkmann Corp.*, Fed. Cir., No. 04-1337, 8/16/05).

Upholding a federal district court's interpretation of this key claim term, and affirming a summary judgment of noninfringement, the court rejected a dictionary-based argument that "transparent" and "translucent" could be synonyms.

#### 360-Degree Signaling Lamp Patented

Stephen K. Terlep holds a patent (5,594,433) relating to an "omni-directional light emitting diode" lamp. The lamp, with no rotating parts, can be used to emit light in all directions, serving for traffic and warning purposes. Terlep sued Brinkmann Corp., alleging that its solar-powered pathway lamps infringed the '433 patent.

Claim 1 of the patent requires that the patented lamp include a "clear plastic tubular holder for tightly holding [a] ... semi-spherical reflector."

Judge Harry F. Barnes of the U.S. District Court for the Western District of Arkansas ruled that the term "clear" should be construed to mean only "transparent" and not "translucent." The holder or covering of the Brinkmann lamp was ribbed and, as a result, not transparent, and thus not within the claim, the district court concluded.

Brinkmann moved for summary judgment of noninfringement, which the district court granted. Terlep appealed.

#### Intrinsic Evidence Excludes Diffusion

Judge Richard Linn addressed Terlep's argument that "clear" should be read to include translucent holders because the patent requires the holder to be clear only to the extent that it allows light through.

However, the court said that the background and prior art sections of the patent note that previous inventions of this type were less effective because of covers that diffused the light, as translucent substances do. The court said:

Implicit in these passages is the distinction between lenses or holders that diffuse or scatter light and those that transmit light without obstruction. The written description is thus consistent with and supports the district court's construction of the term "clear" to refer to holders that are "transparent or [have] the property of transmitting light without appreciable scattering so that bodies lying beyond are seen clearly."

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The court also referenced the prosecution history, which showed that the lack of diffusion resulting from a clear holder served to distinguish the patented invention from prior art.

The court rejected a dictionary-based argument that "transparent" and "translucent" could be synonyms. The dictionary definitions themselves revealed differences in meaning between the two, the court said.

Finally, the court rejected the argument that such a construction of a solely structure-related limitation served to "import a functional limitation into the claim."

According to the court, "[t]he construction properly adopted by the district court merely assigned meaning to the claim term 'clear' and did not impermissibly import a functional limitation."

### Infringement

Applying that claim construction, the Federal Circuit agreed with the district court that there was no infringement.

The court discounted Terlep's observation that some of Brinkmann's products has a translucent cover. None of them has a translucent *holder*, the court stressed, affirming the summary judgment of no literal infringement.

The court similarly turned back Terlep's argument that there was infringement under the doctrine of equivalents. It noted that the "clear" language was part of an amendment that narrowed the scope of the original patent application, thereby surrendering the broader claim scope for purposes of asserting equivalents infringement.

Terlep was represented by Nathan Price Chaney of Nolan Henry, Fayetteville, Ark. Brinkmann was represented by Gary A. Clark of Shepard, Mullin, Richter & Hampton, Los Angeles.



Full text at <http://pub.bna.com/ptcj/041337Aug16.pdf>.



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